



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: GOERING, Thomas

Appl'n No.: 10/665,305

Filing Date: 22 September 2003

For: SYSTEM AND METHOD FOR REUSING FORM  
ELEMENTS IN A FORM BUILDING APPLICATION

Group Art Unit: 2176

Examiner: Singh, Rachna

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Applicant requests review of the final rejections in the Office action mailed August 14, 2006 ("Final Rejection") in connection with the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal.

The review is requested for at least the following reasons:

**ARGUMENTS**

Claims 1-18 are pending in the application. Claims 1, 9 and 17 are the independent claims. (Previously pending claim 19 was canceled in Applicant's October 26, 2006 After-Final Amendment). The pending independent claims follow:

1. **(Original)** A computer system for generating output modules in a form-based application runtime environment, comprising:
  - a form manager component configured to receive an indication that a reusable form element has been changed, determine which output modules from a set of output modules are affected by the changed form element, and invalidate the affected output modules; and
  - a runtime manager component configured to receive a request for an output module from the set of output modules and cause regeneration of the requested output module if the requested output module has been invalidated.
  
9. **(Original)** A computer-implemented method for generating output modules in a form-based application runtime environment, comprising:
  - receiving an indication that a reusable form element has been changed;
  - determining which output modules from a set of output modules are affected by the changed form element;
  - invalidating the affected output modules;
  - receiving a request for an output module from the set of output modules; and
  - regenerating the requested output module if the requested output module has been invalidated.

17. (Original) A computer-implemented dynamic form building method, comprising:
- responsive to a call to start a form output process based on an identified form:
    - determining whether a previously generated output module associated with the identified form in an output module library has been marked as invalid;
    - if so:
      - regenerating the output module; and
      - storing the regenerated output module in the output module library along with a marker to indicate that the output module is valid.

**Hitchcock Clearly Fails To Teach or Suggest Invalidating and Regenerating Output Modules**

Independent claim 9 recites, in part, “invalidating . . . output modules” and “regenerating [a] requested output module if the requested output module has been invalidated”. Independent claim 1 includes similar recitations. Independent claim 17 recites, in part, “determining whether a[n] output module . . . has been marked as invalid” and “if so: regenerating the output module”.

It is clear from the specification and plain meaning that an “output module” is a module that provides output, and is not the output itself. In the context of forms, a form output module processes form data for presentation (e.g., via printer, web browser, etc.). See specification, p. 2, lns 14-16. Thus, form data and form output are entities clearly distinct and separate from a form output module.

The Office rejected the pending claims 35 U.S.C. § 103(a) as being unpatentable over Hitchcock (U.S. Patent Application Publication No. 2005/0080756 A1). However, no aspect of Hitchcock, taken alone or in combination, teaches or suggests invalidation of output modules as claimed.

In fact, Hitchcock explicitly teaches *against* invalidating output modules by stating that “[t]he applicant database can be extended to include new attributes *without making any changes to the forms engine program*”. Hitchcock, para. 0065, lns 1-3 (emphasis added). The essence of

Hitchcock is to provide a universal forms engine or output module that is extensible *without programming* (see Hitchcock, Abstract).

The Office bases all of its rejections on the incorrect notion that the claimed output module can be equated with a form in Hitchcock. See Final Rejection, p. 4, ln 17 – p. 6, ln 7. The Office essentially contends that allowing a user to change the data to be displayed in a form is equivalent to invalidating and regenerating an output module.

As described above, form data and form output are entities *clearly and factually distinct and separate from* a form output module. Thus, the Office's position lacks any factual basis and demonstrates clear error, and therefore should cause the Final Rejection to be withdrawn.

**CONCLUSION**

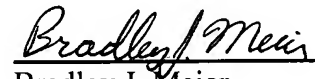
It is respectfully submitted that, in view of the foregoing remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

Although not believed necessary, the Office is hereby authorized to charge any fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

The Office is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

Dated: November 14, 2006

  
Bradley J. Meier  
(Reg. No. 44,236)

KENYON & KENYON LLP  
1500 K Street, N.W., Suite 700  
Washington, D.C. 20005  
(202) 220 - 4200 (telephone)  
(202) 220 - 4201 (facsimile)